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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,599	04/05/2001	Frances H. Arnold	9373/1H222US1	5688

7278 7590 05/01/2003

DARBY & DARBY P.C.  
P. O. BOX 5257  
NEW YORK, NY 10150-5257

EXAMINER

SAUCIER, SANDRA E

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 05/01/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/828,599

Applicant(s)

Arnold et al.

Examiner

Sandra Saucier

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above, claim(s) 32-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 5, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3,7 6) ☐ Other: \_\_\_\_\_

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#### DETAILED ACTION

Claims 1-62 are pending. Claims 1-31 are considered on the merits. Claims 32-62 are withdrawn from consideration as being drawn to a non-elected invention.

#### *Election/Restriction*

Claims 32-62 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 8.

The elected species for examination purposes is toluene dioxygenase.

Applicant's election with traverse of Group I in Paper No. 8 is acknowledged. The traversal is on the grounds that the newly amended claim now requires an oxygen donor and thus, is no longer restrictable from Group I based on the presence or absence of an oxygen donor. While this may be true, the argument for the rejoining of the claimed methods is not found persuasive because the method of Group I forms cis-dihydrodiol as an intermediate product, while the intermediate product of Group II is not required to be cis-dihydrodiol. Thus, a reference which might anticipate the method of Group II would not necessarily anticipate the method of Group I. In the interest of compact prosecution, a new restriction in response to the newly amended claim has not been issued and the elected group has been examined.

It is unlikely that applicant would accept a reference which renders Group II unpatentable as being necessarily applicable to Group I. However, if applicant states on the record that this is true, and that a reference which applies to one group, will be accepted as applying in the same fashion to the other group, the claimed methods may be rejoined.

Applicants' argument that Groups I and II is a subcombination and combination are not persuasive because they are not combination-subcombination. Group I does not require the particulars of Group II nor does Group II require the particulars of Group I.

#### *Information Disclosure Statement*

The listing of the references on PTO 1449 submitted 6/7/01 is incomplete. A proper citation includes AUTHOR, TITLE, JOURNAL, VOLUME,

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NUMBER, INCLUSIVE PAGES, (month), YEAR. The citations are missing the title of the articles.

MPEP37 CFR 1.98(b) requires that each **publication** must be identified by **author, title, relevant pages** of the publication and **date**. The date of publication supplied must include **at least the month** and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue.

Also, a copy of each article listed on the PTO 1449 of 6/7/01 is not found with the application and cannot be located after a search for the references. The examiner has reprinted the US and foreign patent documents and it is not necessary to resubmit these. However, if applicants want the journal references to be considered, a copy of each should be submitted along with a new, properly completed PTO 1449.

***Claim Rejections - 35 USC § 112***  
**INDEFINITE**

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 16, (Gibbs reagent) is in parenthesis. It is unclear if this is an attempt to narrow or expand the claim. Please do not use terms in parenthesis in the claim. Please cancel "Gibbs reagent".

***Allowable Subject Matter***

Claim 1-31 appear to be directed towards allowable subject matter at this time.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30 AM to 5:00 PM Monday and Tuesday and 8:30 AM to noon on Wednesday.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198. The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.

A handwritten signature in black ink, appearing to be 'S. Saucier', with a stylized flourish at the end.

Sandra Saucier  
Primary Examiner  
Art Unit 1651  
April 21, 2003